

### **Remarks/Arguments**

The Office Action mailed July 16, 2003 has been carefully considered. After such consideration, Applicant respectfully requests reconsideration and allowance of Claims 1-22, 24-32 and new Claim 33 in view of the following:

Claims 1-22 and 24-32 stand rejected under 35 U.S.C. 102 (e) as being anticipated by Laverty et al., U.S. Patent No. 6,429,947. Claims 11-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Laverty et al., U.S. Patent No. 6,429,947 as applied to claim 1, and in further view of King et al., U.S. Patent No. 5,956,737.

The present invention relates to the conversion of vector graphics files to files suitable for display on an RGB color computer monitor that receives image data over the Internet. The preferred embodiment of the invention is particularly well suited for producing electronic equivalents of paper print retail catalogs, wherein the electronic catalogs appear to be substantially identical to the paper print retail catalogs. Retailers can promote and sell merchandise such as furniture over the Internet to general viewers and prospective customers using the electronic catalogs of the present invention. Moreover, the preferred embodiment can be used to provide an in-store reprint of selected catalog pages using an inexpensive RGB desktop printer.

On the other hand, Laverty et al. relates to hosting pre-press applications in a printing system that allows automation of printing. Laverty et al. contemplates using the Internet for individual customer feedback in producing individual print jobs to be printed at commercial printing facilities using large commercial CMYK printers. Laverty does not contemplate using the Internet to make available an electronic catalog so general viewers and potential

customers on the Internet will have identically the same image available to them as would be available in a printed catalog.

The Present Invention Is Novel Over Lavery et al. (U.S. Patent No. 6,429,947)

As stated in MPEP §2131, a claim is anticipated under §102 only if each and every element as set forth in the claim, in every detail, is found in a single prior art reference. The claimed invention, according to independent claims 1, 25- 27, and 30-32 as currently amended include a recitation for a step of making the electronic catalog web page available on the Internet for the public to view.

The primary reference, Lavery et al., does not disclose making the electronic catalog web page available on the Internet for the public to view. Instead, Lavery et al. only contemplates hosting a prepress application on a server, wherein an Internet front-end provides a **custom** web site for allowing an **individual** customer to proof a customer-specific prepress order. See Lavery et al. Col. 7, line 46 and Col. 10, lines 63-64. The pages are not generally available pages. In contrast, the electronic catalog web pages of the present invention are presented on a **non-custom** web site for allowing **general** viewers to have identically the same image available to them as would be available in a printed catalog.

As such, Lavery et al. does not anticipate claims 1- 22 and 24-32. Support for the above requirement can be found as original in the present application starting on page 1, lines 17-20. Thus, no new matter has been added by these amendments.

The Present Invention Is Not Obvious Over The Cited References

The Federal Circuit has ruled on numerous occasions that a holding of "obviousness" requires some motivation, suggestion or teaching within the cited references that would lead one skilled in the art to modify the cited reference or references as claimed by applicant. See,

for example, *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000):

"Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

There is no motivation to make customer-specific pages generated in Lavery available on the Internet for the general public to view, so an obviousness rejection based on Lavery would be inappropriate.

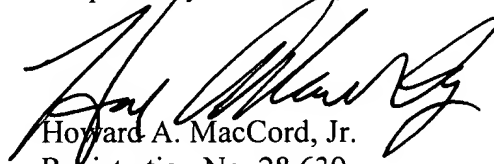
Regarding Claim 30 and new Claim 33, the cited Lavery et al. patent and cited U.S. Patent No. 5,956,737 to King et al. both describe method steps that include raster image processing. The claims of the present application also describe method steps that include raster image processing. However, the applicant's method steps as currently specifically claimed, incorporate a step of correcting text errors through the use of error correction routines to correct the text errors that occur when the vector graphics data file was converted from its native file format to a bit map graphics file format. Neither Lavery et al. nor King et al. mention, teach or suggest the above step.

Moreover, Lavery et al. actually teaches away from using **text error correction routines** by pointing out that the Print Ready File already has each element precisely mapped. Lavery goes on to say: "Because no human is required to alter it, the data for the product and the location of its elements need not change. (Please see column 8, lines 19-45.) In contrast,

the present invention is more robust with regard to text elements, allowing a less than perfect vector file to BMP file conversion. As a result of this robustness, the present invention includes process steps that incorporate text error correction routines. On the other hand, Lavery teaches vector file to BMP file conversion without the use of text error correction routines. Therefore, one skilled in the art is **not** motivated to modify Lavery et al. to incorporate the steps that use the text error correction routines. Thus, there cannot be a prima facie case of obviousness with respect to the present invention.

Furthermore, none of the prior art cited, but not applied, teach, mention or suggest alone or in combination any of the above limitations. Therefore, in view of the foregoing amendments and for the above reasons, it is believed that this application is now in condition for allowance. If unresolved issues remain, the Examiner is invited to telephone applicant's attorney at the number below.

Respectfully submitted,



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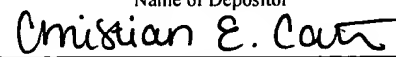
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